

This Opinion is Not a
Precedent of the TTAB

Mailed: October 13, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re Destino Xcaret S.A.P.I. de C.V.*¹

Serial No. 88622747

Vivian Ortiz-Ponce of Marcas Estados Unidos,
for Destino Xcaret S.A.P.I. de C.V.

Nelson Snyder, Trademark Examining Attorney, Law Office 107,
J. Leslie Bishop, Managing Attorney.

Before Bergsman, Adlin, and Dunn,
Administrative Trademark Judges.

Opinion by Dunn, Administrative Trademark Judge:

Destino Xcaret S.A.P.I. de C.V. (“Applicant”) seeks registration on the Principal



Register of the mark for “Contract food and beverage services; Hotel

¹ On February 10, 2021, application Serial No. 88622747 was assigned from Experiencias Xcaret Hoteles S.A.P.I. de C.V. to Destino Xcaret S.A.P.I. de C.V., and the assignment was recorded with the USPTO Assignment Branch at Reel 7209, Frame 0942.

accommodation services; Hotel and restaurant services; Hotel services; Preparation of food and beverages; Restaurant services, namely, providing of food and beverages for consumption on and off the premises; Serving food and drinks; Tourist inns; Bed and breakfast inn services” in International Class 43.² The application includes a disclaimer of the term HOTEL XCARET MEXICO, and the description:

The mark consists of the stylized wording “HOTEL XCARET MEXICO” appearing below an abstract design of a tree featuring abstract drawings on and around the tree. The center of the tree trunk has a stylized turtle formed in part from a geometric spiral. A stylized sun and a crescent moon appears above the top of the tree and is partially enclosed by tree branches. A stylized parrot appears above a branch below the sun design, and a stylized toucan appears above a branch below the crescent moon. A stylized frog appears on a branch below the parrot, and a stylized deer appears on a branch below the toucan. A stylized tiger head appears on the center of the tree above the turtle, and a stylized flower appears on a branch to the left and right of the tiger head.

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as applied to the services identified in the application, so resembles the mark HOTELXCARETRESORT.COM for “Travel services, namely, making reservations and bookings for temporary lodging; making hotel and temporary lodging reservations for individuals and groups via a global computer network,” in

² Application Serial No. 88622747 was filed September 19, 2019, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce.

The Trademark Status and Document Retrieval (TSDR) citations refer to the downloadable .pdf version of the documents available from the electronic file database for the involved application. The TTABVue citations refer to the Board’s electronic docket, with the first number referring to the docket entry and the second, if applicable, to the page within the entry.

International Class 43,³ as to be likely to cause confusion, to cause mistake, or to deceive.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

I. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that “so resembles a mark registered in the Patent and Trademark Office” as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Marks registered on the Supplemental Register are “marks registered in the Patent and Trademark Office” and may be used as a basis for refusing registration under Section 2(d) due to a likelihood of confusion. *Id.*; *In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 49 (Fed.Cir.1986); *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1743 (TTAB 2016). While the strength of the cited mark is always relevant to assessing the likelihood of confusion, the citation of registrations on the Supplemental Register does not involve a different test for likelihood of confusion. *See In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 341 (CCPA 1978) (“[n]o reason exists, however, for the application of different standards to registrations cited under 2(d).”); *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d at 1744 (“there is no

³ Registration No. 5577658 issued October 2, 2018 on the Supplemental Register.

categorical rule that citation of registrations on the Supplemental Register is limited to registrations of ‘substantially identical’ marks for ‘substantially similar goods’”).


Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each relevant *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1628 (TTAB 2018).

A. Similarity or Dissimilarity of the Services

We turn to the similarity or dissimilarity of the respective services. When determining whether services are related, we must consider the services as they are identified in the respective recitation of services in the application and cited registration. *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods”). *See also Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937,

16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed”).



Applicant seeks to register its  mark for “Contract food and beverage services; Hotel accommodation services; Hotel and restaurant services; Hotel services; Preparation of food and beverages; Restaurant services, namely, providing of food and beverages for consumption on and off the premises; Serving food and drinks; Tourist inns; Bed and breakfast inn services.” The cited HOTELXCARETRESORT.COM registration lists “Travel services, namely, making reservations and bookings for temporary lodging; making hotel and temporary lodging reservations for individuals and groups via a global computer network lists.” We find a relationship between the services based on the recitations themselves, which include “hotel accommodation services” in the subject application and “making hotel and temporary lodging reservations for individuals and groups via a global computer network lists” in the cited registration. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (“While additional evidence, such as whether a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis, the Board did not consider

the important evidence already before it, namely the ITU application and HP's registrations.”).

The close relationship between hotel accommodation services and hotel reservation services is corroborated by the record evidence demonstrating use of the same mark for these services by Hilton, MGM Grand, The Cliff House, Marriott, The Broadmoor, Disney World, and the Brown Palace Hotel and Spa.⁴ The example below, which is typical of the others in the record, shows use of the same mark in connection with the services:

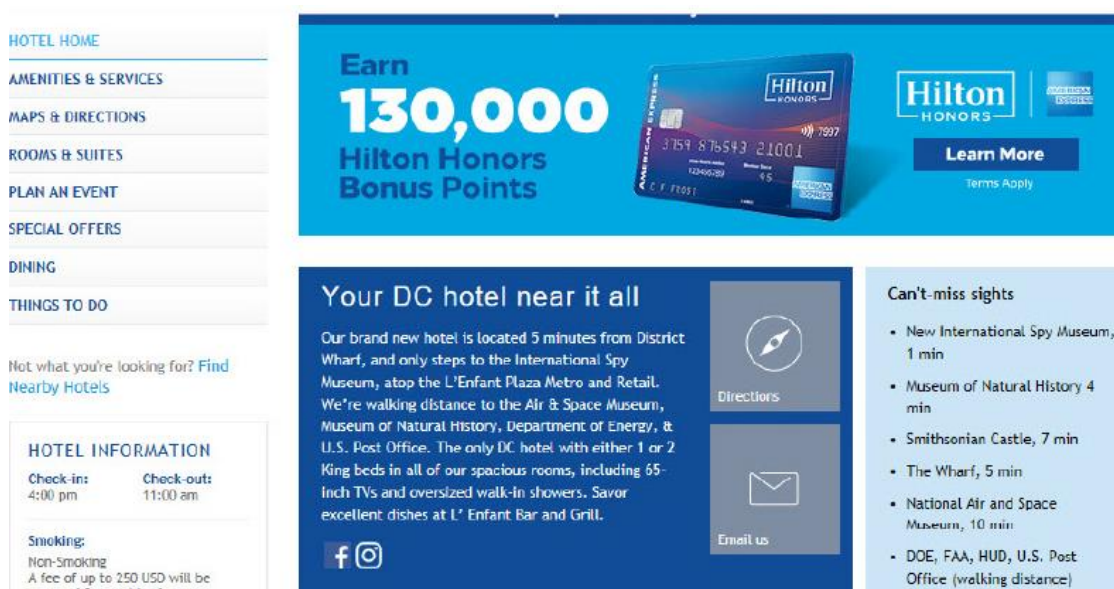


Figure 1 Excerpt describing Hilton hotel services⁵

⁴ July 22, 2020 Office Action TS DR 52-132.

⁵ December 30, 2019 Office Action TS DR 53.

Figure 2 Excerpt describing Hilton hotel reservation services⁶

Evidence that consumers encounter one mark designating a single source for the services of both parties supports a finding that the services are related. *Hewlett-Packard Co. v. Packard Press, Inc.*, 62 USPQ2d at 1005; *In re I-Coat Co.*, 126 USPQ2d 1730, 1738 (TTAB 2018).

In addition, the record includes 27 third-party use-based registrations showing the same mark used for hotel accommodation services such as those offered by Applicant, and hotel and temporary lodging reservation services such as those offered by Registrant.⁷ A representative sample is shown below:

Reg. No.	Mark	Services
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⁶ December 30, 2019 Office Action TSDR 56.

⁷ December 30, 2019 Office Action TSDR 9-51, July 22, 2020 Office Action TSDR 7-51.

5941566 ⁸	LONE MOUNTAIN RANCH	Hotel, lodging and hospitality services, namely, providing temporary accommodations; restaurant and bar services; providing meeting and conference room facilities; travel agency services, namely, making reservations and booking for temporary lodging services; nursery and child care services
5907770 ⁹	TANEYCOMO LANDING	hotel services; restaurant, catering, and bar services; resort lodging services; provision of general purpose facilities for meetings, conferences, and exhibitions; provision of banquet and social function facilities for special occasions; and reservations services for hotel accommodations for others
5376035 ¹⁰	HOTEL FIGUEROA DOWNTOWN LOS ANGELES	Hotel and resort services; provision of general purpose facilities for meetings, conferences and exhibitions; travel agency services, namely, making reservations for hotel accommodations and reservations and bookings for restaurants and meals; bar services; cocktail lounges; cocktail lounge services; restaurant services;

Third-party registrations for services listed in both the application and registration at issue based on use in commerce may have probative value to the extent that they serve to suggest that the listed services are of a type that may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd mem.* 864 F.2d 149 (Fed. Cir. 1988).

⁸ December 30, 2019 Office Action TSDR 22.

⁹ December 30, 2019 Office Action TSDR 39.

¹⁰ July 22, 2020 Office Action TSDR 10.

Under this *DuPont* factor, the Trademark Examining Attorney need not prove, and we need not find, similarity as to each and every activity listed in the description of services. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any activity encompassed by the identification of services in a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d at 1409.

Finally, Applicant does not dispute that the services are closely related but contends that the differences between the marks are sufficient to avoid likelihood of confusion


For these reasons we find the relationship between the services weighs in favor of a finding of likelihood of confusion.

B. Established, likely-to-continue channels of trade and classes of consumers.

As demonstrated by the Internet evidence discussed above, consumers who use hotel services, including hotel accommodation services, also use hotel reservation services. It is logical that consumers seeking hotel services will use hotel reservation services to reserve a hotel room. Accordingly, we find that the services at issue are offered through the same channels of trade and sold to the same classes of consumers.

C. Similarity or Dissimilarity of the Marks



We consider the similarity or dissimilarity of the marks  and HOTELXCARETRESORT.COM in their entireties as to appearance, sound, connotation, and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1689 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d*, Slip Op. No. 18–2236 (Fed. Cir. Sept. 13, 2019) (mem) (*quoting In re Davia*, 110 USPQ2d at 1812). The proper focus is on the recollection of the average purchaser, who retains a general impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d at 1960 (*citing Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)). Here, the average purchaser of hotel services and hotel reservation services is a traveler in need of accommodations.

We first assess the cited mark’s inherent distinctiveness. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1181 (Fed. Cir. 2004) (“marks have traditionally been categorized along the following range of increasing distinctiveness: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, or (5) fanciful.”). Marks that are descriptive or highly suggestive are entitled to a narrower scope of protection, *i.e.*, are less likely to generate confusion over source identification,

than their more fanciful counterparts. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015).

We find that the registered mark is merely descriptive of the registered “Travel services, namely, making reservations and bookings for temporary lodging; making hotel and temporary lodging reservations for individuals and groups via a global computer network lists.” *In re Alpha Analytics Investment Group LLC*, 62 USPQ2d 1852, 1856 (TTAB 2002) (registrations under Trademark Act § 2(f) or on the Supplemental Register, although not conclusive evidence, may be probative evidence of mere descriptiveness). *Accord Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 1299, 59 CCPA 764, 767, 172 USPQ 361, 363 (1972)(“We also agree with the observation of the board that, when appellant sought registration of SUPER BLEND on the Supplemental Register, it admitted that the term was merely descriptive of its goods and that when it disclaimed said term in applications for registrations of compound marks, it again admitted the merely descriptive nature of the mark and acknowledged that it did not have an exclusive right therein at that time.”). In fact, the mark immediately conveys that Registrant’s reservation services involve hotels/resorts in Xcaret. because “XCARET” identifies a location on the Caribbean coastline of the Yucatan Peninsula in Mexico offering water attractions and recreation.¹¹

The top-level domain “.COM” at the end of the mark has no source indicating significance, but shows that the mark also acts as a URL designating a commercial

¹¹ December 30, 2019 Office Action TSDR 58-75.

entity. *See In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789, 1792 (TTAB 2002) (“Simply put, the TLD ‘.com,’ as shown by the Examining Attorney’s evidence, signifies to the public that the user of the domain name constitutes a commercial entity.”). Because the registered mark HOTELXCARETRESORT.COM is merely descriptive of the registered services, we find it is entitled to less protection than we would give a distinctive mark.

Applicant argues that it “has the exact same right as the owners of the cited registration to let consuming public know that it provides hotel services in Xcaret, Mexico.”¹² However, the cited registration is more than the term HOTEL XCARET. We must compare the marks in their entirety.

Comparing the registered mark HOTELXCARETRESORT.COM to Applicant’s



mark, both marks notably begin with the identical term HOTEL XCARET, and we find that this initial term HOTEL XCARET, descriptive as it is,¹³ forms the dominant feature of both marks. *See Palm Bay Imps.*, 73 USPQ2d at 1692 (“To be sure, CLICQUOT is an important term in the mark [VEUVE CLICQUOT], but VEUVE nevertheless remains a ‘prominent feature’ as the first word in the mark and

¹² 15 TTABVue 5.

¹³ In addition to our finding that the term HOTEL XCARET is descriptive in the registered mark, the term HOTEL XCARET has been treated as merely descriptive in Applicant’s mark, where it is disclaimed (with all other wording). *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1442 (TTAB 2005) (“it has long been held that the disclaimer of a term constitutes an admission of the merely descriptive nature of that term ... at the time of the disclaimer”).

the first word to appear on the label.”); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“Although there are differences in appearance between the marks [KID WIPES and KID STUFF], there are also similarities between them in that both start with the term ‘KID’ (a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered) and have the same number of letters and syllables.”). Because all of the literal terms in both marks are merely descriptive, there is no more distinctive literal element to preclude us finding, as is usually the case, that the first words are those contributing most to the overall commercial impression of the mark. *In re Detroit Athletic Co.*, 903 F3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (“The identity of the marks’ initial two words is particularly significant because consumers typically notice those words first.”).

We find that the remaining literal elements of each mark merely reinforce the words HOTEL XCARET. Because Xcaret identifies a resort area, and the services are available online, the addition of RESORT.COM does not alter the dominant commercial impression created by the term HOTEL XCARET when the registered mark HOTELXCARETRESORT.COM is applied to hotel reservation services. *See In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1375 (Fed. Cir. 2004) (“Rather, the addition of “.com” to the term “patents” only strengthens the descriptiveness of the mark in light of the designation of goods in the application.”). Similarly, because Xcaret is located in Mexico, the addition of MEXICO does not alter

the dominant commercial impression created by the term HOTEL XCARET when



Applicant's mark is applied to hotel services.

Applicant disputes that HOTEL XCARET forms the dominant part of its mark, and contends “[w]hat is distinctive and unique about [Applicant’s] mark is its graphic design.”¹⁴ We disagree. In a stylized mark, or a mark comprising word and design elements, the verbal portion likely will be the dominant portion. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012) (“the verbal portion of a word and design mark likely will be the dominant portion ... given that the literal component of brand names likely will appear alone when used in text and will be spoken when requested by consumers.”).

We do not dismiss the visual impact of the letter X carrying and surrounded by



flora and fauna designs above the wording in Applicant's mark, and we agree that the registered mark visually differs from Applicant's mark.¹⁵ However, the test is not whether Applicant's mark can be distinguished from the registered mark but whether they are so similar that confusion is likely. As noted, the design element

¹⁴ 15 TTABVue 5.

¹⁵ Applicant's exclusion of the letter X from its description of its mark does not preclude us from seeing the letter X and including it in our assessment.

of a mark is not involved when a customer calls for the goods by voice or in writing. *In re Viterro Inc.*, 101 USPQ2d at 1911 (The verbal portion of a word and design mark “likely will appear alone when used in text and will be spoken when requested by consumers.”).

Moreover, we find that the stylized letter X in Applicant’s mark reinforces the impression that the services involve Xcaret. *See UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1887 (TTAB 2011) (“The ‘M’ in the first design mark above merely reinforces the first letter in MOTOWN, and the font and square border are insignificant.”); *In re Continental Graphics Corp.*, 52 USPQ2d 1374, 1376 (TTAB 1999) (“Indeed, the dominant role of the word CONTINENTAL in the overall commercial impression created by the registered mark is reinforced, rather than negated, by the inclusion in the mark of the globe design depicting stylized continents and the inclusion of the large letter ‘C,’ which is the first letter of the word CONTINENTAL.”).

Finally, Applicant describes the design element of its mark as “a tree featuring abstract drawings on and around the tree” While distinctive, we find that the design is not so novel or visually arresting as to diminish the dominant role of the wording in the mark. *Compare In re Calder*, Serial No. 4808681, 2015 TTAB LEXIS 17 (TTAB January 29, 2015) (CALIFORNIA REPUBLIC in standard characters for



clothing not likely to be confused with composite mark also for clothing.)

Although we consider the marks as a whole, “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. . . .” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Addressing the marks in their entirety, we find that the similarity created by the inclusion of the dominant, shared term HOTEL XCARET is not diminished by either the addition of the term RESORTS.COM in the registered mark or the term MEXICO and the letter X decorated with plants and animals in Applicant’s mark. *See In re Viterra Inc.*, 101 USPQ2d at 1911 (“we previously have found that the dominant portion of a composite word and design mark is the literal portion, even where the literal portion has been disclaimed.”). We find, as a result, that the differences between the marks are outweighed by their similarities. We find that the first *DuPont* factor, similarity of the marks, also weighs in favor of finding likelihood of confusion.


D. Balancing the Factors

We have considered all of the arguments and evidence of record, and all relevant *DuPont* factors. When we balance the *DuPont* factors, we conclude that confusion is

likely to occur between Applicant's mark and Registrant's mark for their respective services.

II. **Decision**



The refusal to register Applicant's mark  is affirmed.